

REMARKS

Claims 1-25 are pending. Claim 26 has been added. Support for claim 26 is in the specification at page 9, line 2. The Advisory Action mailed October 16, 2002 states that the response and declaration filed September 23, 2002 were considered but did not place the application in condition for allowance. The Advisory Action appears to maintain only 35 U.S.C §§ 102(b) and 103(a) rejections based on Francis and Siminoski et al.

Regarding the Francis document, the Advisory Action alleged that there was not enough information in the declaration concerning the nature of the communication and relationship between Dr. Francis and National Silicates Ltd. Applicants submit herewith a Second Declaration by Dr. Francis clarifying the date and distribution of a document referred to in his declaration of September 20, 2002. This Second Declaration verifies that the date of any distribution related to the subject interim report occurred *after* the filing date of the present application. The Advisory Action requests that such disclosure be submitted to the Patent Office. The requested documentation was distributed to participants at a confidential scientific meeting. The applicants are not obliged to breach confidentiality by supplying the documentation in this instance because the date of distribution (i.e., after the filing date of the patent application) renders the document immaterial to the patentability of the instant application.

The Advisory Action stated that the declaration was "not clear as to what was the relationship between Dr. Francis and National Silicates Ltd." Paragraph 2 of the declaration date September 20, 2002, stated that Dr. Francis and National Silicates Ltd. entered into a research collaboration, making it clear that the nature of the relationship was one of research collaborators. The Advisory Action further stated that based on the declaration "it is not clear who had access to the communication" and "whether or not National Silicates Ltd. agreed to keep the report confidential." Enclosed is a Declaration of Dr. Timothy Evans, of National Silicates, Ltd. In this declaration, Dr. Evans 1) supports Dr. Francis' statements regarding the nature of the research collaboration between National Silicates Ltd. and Dr. Francis, and 2) verifies that the Interim Reports received by National Silicates Ltd. from Dr. Francis were not distributed outside the research collaboration.

Regarding the Siminoski et al. reference (U.S. Patent No. 4,915,785), the Advisory Action stated that “[a] comparison has not been made to the 1:16 of Siminoski which is very close to the claimed 1:15 ratio.” In the Responses filed December 19, 2001 and September 23, 2002, applicants presented extensive explanation of the distinctions between Siminoski et al. and the present application.

*(initials)*

Specifically, at page 5, first paragraph of the December 19, 2001 response, applicants establish that Siminoski et al. teach a composition for a MECHANICAL pulp, whereas the present invention concerns a CHEMICAL pulp, and notes that the identical treatment may induce disparate effects in a chemical pulp as opposed to a mechanical pulp. Furthermore, at page 5, second paragraph, the December 19, 2001 response notes that Siminoski et al. teach away from increasing the Mg:SiO<sub>2</sub> ratio, as Siminoski et al. report improved performance when the Mg:SiO<sub>2</sub> ratio decreases. The highest Mg:SiO<sub>2</sub> ratio presented by Siminoski et al. (1:16 in first composition of Table 1) has the poorest brightening results. Further “comparison” between the least successful example of Siminoski et al. with the present invention is not possible or relevant, because Siminoski et al. present results for MECHANICAL pulps (containing greater than 20-25% lignin) and the instant claims are directed towards “pulps containing less than 18% lignin.”

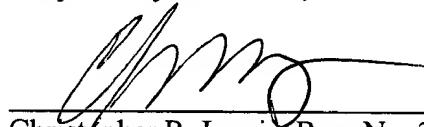
Because the Advisory Action indicates that Siminoski et al. does not disclose a combination in the range as claimed, Siminoski et al. must satisfy the requirements for obviousness to support a rejection. Clearly, there is no motivation to modify a combination used for mechanical pulps in application to chemical pulps, as the respective pulps respond differently to similar treatments (See specification, page 1, line 27 to page 2, line 13). Generally, results obtained with mechanical pulps cannot be considered predictive for chemical pulps.

Finally, the Office has repeatedly neglected to address the claim language “wherein at least 25% of the silicates have a molecular weight of at least 10,000 Daltons.” None of the cited art disclose or suggest a combination in which a significant portion of the silicates are of high molecular weight. This aspect of the invention is responsible in part for the improved brightness achieved by the invention. The specification explains that higher molecular weight silicates aid in sequestering

transition metals which otherwise would be available to undesirably react with hydrogen peroxide (page 6, lines 15-24).

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance and respectfully request early and favorable notification to that effect. If it would expedite prosecution of this application, the Examiner is invited to confer with Applicants' undersigned representatives.

Respectfully submitted,

  
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PDP/

Enclosures: Second Declaration of Raymond C. Francis;  
Declaration of Timothy Evans  
Version with Markings to Show Changes Made

Dated: October 23, 2002

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October 23, 2002

Date

  
Christopher R. Lewis

*VERSION WITH MARKINGS TO SHOW CHANGES MADE*

IN THE CLAIMS:

Claim 26 has been added.